



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
**United States Patent and Trademark Office**  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
15/603,275	05/23/2017	Michael James LeBeau	079894.4765	1622
91230	7590	09/30/2020	EXAMINER	
BAKER BOTTS L.L.P./FACEBOOK INC. 2001 ROSS AVENUE SUITE 900 DALLAS, TX 75201			WON, MICHAEL YOUNG	
			ART UNIT	PAPER NUMBER
			2449	
			NOTIFICATION DATE	DELIVERY MODE
			09/30/2020	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Cal-PTOmail@bakerbotts.com  
judy.wan@bakerbotts.com  
ptomail1@bakerbotts.com

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

*Ex parte* MICHAEL JAMES LEBEAU, SAMUEL WHARTON LESSIN,  
JOSEPH DAVID BARILLARI, AMIR SHIMONI,  
ARLENE GABRIANA MURILLO, MATEUSZ MAREK NIEWCZAS,  
MANISH MODI and CAITLIN E. KALINOWSKI

---

Appeal 2019-004159  
Application 15/603,275  
Technology Center 2400

---

Before ST. JOHN COURTENAY III, LARRY J. HUME, and  
PHILLIP A. BENNETT, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant<sup>1</sup> appeals under 35 U.S.C. § 134(a) from a Final Rejection of claims 1–43. We have jurisdiction over the pending claims under 35 U.S.C. § 6(b).

We Affirm in Part.

---

<sup>1</sup> We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42(a) (2018). According to Appellant, the real party in interest is Facebook, Inc. *See* Appeal Br. 3.

STATEMENT OF THE CASE <sup>2</sup>

*Introduction*

Appellant’s claimed invention “relates to exchanging information over wireless communications sessions, particularly within the context of an online social network.” Spec. ¶ 2.

*Independent Claim 1*

1. A method comprising, by one or more computing devices of an online social network:
  - receiving session information associated with a first user of the online social network, wherein:
    - the session information comprises an identifier of the first user and information indicating that a current wireless communication session has been established between a first client system of the first user and a beacon associated with a particular third-party, wherein:
      - the beacon is proximate to the first client system at the time of the current wireless communication session; and
      - the current wireless communication session allows the online social network to send social-networking information of the first user to the third-party;
    - receiving a request for social-networking information associated with the first user;
    - determining a category associated with the third-party;
    - accessing a set of social-networking information associated with the first user;

---

<sup>2</sup> We herein refer to the Final Office Action, mailed Oct. 16, 2018 (“Final Act.”); Appeal Brief, filed Jan. 31, 2019 (“Appeal Br.”); the Examiner’s Answer, mailed March 18, 2019 (“Ans.”); and the Reply Brief, filed May 3, 2019 (“Reply Br.”).

*determining one or more types of social-networking information corresponding to the determined category associated with the third-party;*

*retrieving a particular subset of social-networking information from the accessed set of social-networking information associated with the first user based on the determined one or more types of social-networking information corresponding to the determined category associated with the third-party; and*

sending, responsive to receiving the request, the session information associated with the first user and the retrieved subset of social-networking information associated with the first user to a third-party system of the third-party for display.

Claims Appendix, Appeal Br. 12 (emphasis added regarding the disputed “determining” and “retrieving” steps under anticipation Rejection A).

#### *Evidence*

The prior art relied upon by the Examiner as evidence is:

<b>Name</b>	<b>Reference</b>	<b>Date</b>
Cox et al. (“Cox”)	US 2011/0314065 A1	Dec. 22, 2011
Spencer et al. (“Spencer”)	US 2012/0192258 A1	July 26, 2012

#### *Rejections*

<b>Rej.</b>	<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>
A	1, 6–20, 25–43 <sup>3</sup>	102(a)	Spencer
B	2–5, 21–24	103	Spencer, Cox

<sup>3</sup> We have corrected a typographical error in the Examiner’s listing of claims for Rejection A under 35 U.S.C. § 102(a) on page 4 of the Final Action. Although the Examiner indicates that claims 1, 6–20, and 25–39 are rejected over Spencer, a detailed anticipation rejection for claims 40–43 over Spencer is found on page 16 of the Final Action. As corrected above, claims 1, 6–20, and 25–43 are rejected under § 102(a) Rejection A.

*Analysis*

In reaching this Decision, we consider all evidence presented and all arguments actually made by Appellant. To the extent Appellant has not advanced separate, substantive arguments for particular claims, or other issues, such arguments are waived. 37 C.F.R. § 41.37(c)(1)(iv).

*Rejection A under § 102 of Claims 1, 6–20, and 25–43*

*Issues under § 102*

Under 35 U.S.C. § 102(a), we focus our analysis on the argued “determining” and “retrieving” steps regarding anticipation Rejection A of independent method claim 1.

**Issues:** Did the Examiner err by finding Spencer expressly or inherently discloses the disputed, dispositive steps:

*determining one or more types of social-networking information corresponding to the determined category associated with the third-party;*

*retrieving a particular subset of social-networking information from the accessed set of social-networking information associated with the first user based on the determined one or more types of social-networking information corresponding to the determined category associated with the third-party;*

within the meaning of independent claim 1? (emphasis added).<sup>4</sup>

We note that Appellant states: “Independent Claims 19 and 20 recite similar limitations.” Appeal Br. 7.

---

<sup>4</sup> We give the contested claim limitations the broadest reasonable interpretation consistent with the Specification. See *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

*Analysis*

The Examiner relies upon Spencer’s description, at paragraphs 30, 49, 68 (Final Act. 5–6) for disclosing the “determining” step, and upon Spencer’s paragraphs 30, 49, 67, 68 for disclosing the “retrieving” step (Final Act. 6).

The Examiner expands his findings in the Answer and further reads the “social-network information” recited in the “retrieving” step of claim 1 on Spencer’s description at paragraph 50, in which “a user posts a particular preference for the products offered by a given coffee house chain on their social networking profile.” When the user uses the credentials associated with this particular profile at a hotspot from the coffee house chain, they may be provided with a free coffee offer. *See* Ans. 4–5 (citing Spencer ¶ 50).

Appellant argues that the Examiner cites to different embodiments in paragraphs 50 and 67 for disclosing the “retrieving” limitation. Reply Br. 6. Appellant specifically contends:

[P]aragraph 0050 is a distinct embodiment from paragraph 0067 such that the Examiner is impermissibly selecting aspects of one embodiment of *Spencer* and combining them with aspects of a separate embodiment of *Spencer*. In particular, *Spencer* teaches two distinct, non-overlapping embodiments - paragraph 0050 discloses service customization based on a user profile, while paragraph 0067 discloses access control to various services based on user attributes. Independent Claim 1 includes multiple steps; however, the Examiner's Answer relies on the embodiment of paragraph 0050 for teaching the first four steps of “receiving,” “determining,” “accessing,” and “determining,” and the embodiment of paragraph 0067 for teaching the fifth step of “retrieving.”

Reply Br. 6–7.

Appellant further urges:

the teachings of paragraphs 0050 and 0067 relate to entirely different and non-overlapping embodiments. Notably, the Examiner has not cited to any portions of *Spencer* where the service customization process of paragraph 0050 is used with the access control process of paragraph 0067. Accordingly, the rejection of independent Claim 1 based on a combination of paragraphs 0050 and 0067 is improper because *Spencer* does not actually teach the arrangement of elements on which the Examiner's Answer relies. See MPEP § 2131 (8th ed. Rev. 9, Aug. 2012) (reference must teach every element “arranged as required by the claim” to anticipate); see also *In re Arkley*, 455 F.2d 586, 587-88 (CCPA 1972) (“picking and choosing” between distinct embodiments is improper in making an anticipation rejection).

Reply Br. 7.

Based upon our review of *Spencer*, we agree with the positions articulated by the Appellant regarding the Examiner's improper reliance on separate, distinct embodiments in *Spencer* to support anticipation Rejection A. *Id.*

In particular, the respective portions of *Spencer*'s paragraphs 50 and 67 that are relied upon by the Examiner refer to *different disclosed embodiments*, as indicated by the first sentence of each paragraph: e.g., “Fig. 10 provides an example of an attribute targeting process . . . .” (para. 67), “As a further example, and in accordance with an embodiment of the invention, a user whose social networking profile identifies them as having particular interests may be directed to a network access landing page related to this particular interest . . . .” (para. 50).

Although “combining two embodiments disclosed adjacent to each other in a prior art patent does not require a leap of inventiveness” (*Boston*

*Scientific Scimed, Inc. v. Cordis Corp.*, 554 F.3d 982, 991 (Fed. Cir. 2009)), we emphasize the court in *Boston Scientific Scimed* was considering a question of *obviousness*, in contrast to the question of *anticipation* presented here.

Because of the Examiner’s reliance upon *multiple distinct embodiments* in Spencer, Appellant’s argument is persuasive. See Reply Br. 6–7.<sup>5</sup> We agree that the claimed retrieving of “*a particular subset of social-networking information from the accessed set of social-networking information associated with the first user based on the determined one or more types of social-networking information corresponding to the determined category associated with the third-party*” is not anticipated by Spencer. See independent claims 1, 19, and 20 (emphasis added). We note that the aforementioned limitations argued by Appellant are similarly recited in commensurate form in each independent claim 1, 19, and 20.

Therefore, for essentially the same reasons argued by Appellant (Reply Br. 6–7), we are constrained on this record to reverse the Examiner’s anticipation Rejection A for each independent claim 1, 19, and 20 on appeal. Because we have reversed the Examiner’s Rejection A of each independent

---

<sup>5</sup> To anticipate under § 102, the prior art reference “must not only disclose all elements within the four corners of the document, but must also disclose those elements arranged as in the claim.” *Net MoneyIn, Inc. v. Verisign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008) (citation and internal quotation marks omitted). “Thus, it is not enough that the prior art reference discloses part of the claimed invention, which an ordinary artisan might supplement to make the whole, or that it *includes multiple, distinct teachings that the artisan might somehow combine to achieve the claimed invention.*” *Id.* at 1371 (emphasis added).

claim, we also reverse the Examiner's anticipation Rejection A for dependent claims 6–18 and 25–43.

*Section 103 Rejection B of Dependent Claims 2–5 and 21–24*

Regarding the § 103 rejection of dependent claims 2–5 and 21–24, Appellant contends that “even if the proposed *Spencer–Cox* combination were proper, it would still fail to disclose, teach, or suggest all the limitations of dependent Claims 2–5 and 21–24.” Reply Br. 7.

However, we note that that Appellant's argument regarding the Examiner's improper reliance on separate, distinct embodiments of Spencer in the context of anticipation is inapplicable to the Examiner's reliance upon separate embodiments of Spencer (and the secondary Cox reference) in the context of obviousness. *See Boston Scientific Scimed, Inc.* 554 F.3d at 991 (“combining two embodiments disclosed adjacent to each other in a prior art patent does not require a leap of inventiveness”).

Because Appellant has not shown reversible error<sup>6</sup> in the Examiner's obviousness rejection of dependent claims 2–5 and 21–24, we sustain the

---

<sup>6</sup> *See In re Jung*, 637 F.3d 1356, 1365 (Fed. Cir. 2011) (“Jung argues that the Board gave improper deference to the examiner's rejection by requiring Jung to ‘identif[y] a reversible error’ by the examiner, which improperly shifted the burden of proving patentability onto Jung. *Decision* at 11. This is a hollow argument, because, as discussed above, the examiner established a *prima facie* case of anticipation and the burden was properly shifted to Jung to rebut it. . . . ‘[R]eversible error’ means that the applicant must identify to the Board what the examiner did wrong . . .”).

Examiner's § 103 Rejection B of these claims.<sup>7</sup>

### CONCLUSIONS

The Examiner erred in rejecting claims 1, 6–20, and 25–43, as being anticipated under 35 U.S.C. § 102(a), over Spencer.

Appellant has not shown the Examiner erred in rejecting claims 2–5 and 21–24, as being obvious under 35 U.S.C. § 103, over the cited combination of Spencer and Cox.

### DECISION SUMMARY

Rej.	Claims Rejected	35 U.S.C. §	Reference(s)/ Basis	Affirmed	Reversed
A	1, 6–20, 25–43	102(a)	Spencer		1, 6–20, 25–43
B	2–5, 21–24	103	Spencer, Cox	2–5, 21–24	
	<b>Overall Outcome</b>			2–5, 21–24	1, 6–20, 25–43

---

<sup>7</sup> We decline to set forth new grounds of rejection under § 103 in this Decision. *But cf. Callaway Golf Co. v. Acushnet Co.*, 576 F.3d 1331, 1344 (Fed. Cir. 2009) (“A broader independent claim cannot be nonobvious where a dependent claim stemming from that independent claim is invalid for obviousness.”); *Avantis Pharma Deutschland GmbH v. Lupin, Ltd.*, 499 F.3d 1293, 1300 (Fed. Cir. 2007); *Ormco Corp. v. Align Tech., Inc.*, 498 F.3d 1307, 1319–20 (Fed. Cir. 2007) (law of the case that a dependent claim was obvious means the parent claim must also have been obvious); *In re Muchmore*, 433 F.2d 824, 25 (CCPA 1970) (“Since we agree with the [B]oard’s conclusion of obviousness as to these narrow claims, the broader claims must likewise be obvious.”). We leave this additional issue of obviousness to the Examiner’s consideration in the event of further prosecution of this application. Although the Board is authorized to reject claims under 37 C.F.R. § 41.50(b), no inference should be drawn when the Board elects not to do so. *See Manual of Patent Examining Procedure (MPEP) § 1213.02.*

Appeal 2019-004159  
Application 15/603,275

FINALITY AND RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv). *See* 37 C.F.R. § 41.50(f).

AFFIRMED IN PART